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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,170	07/15/2003	Timothy G. Nye	3014.1001-001	9489
21005	7590	10/31/2005	EXAMINER	
HAMILTON, BROOK, SMITH & REYNOLDS, P.C. 530 VIRGINIA ROAD P.O. BOX 9133 CONCORD, MA 01742-9133			WOO, ISAAC M	
			ART UNIT	PAPER NUMBER
			2166	

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/620,170	NYE, TIMOTHY G.	
	Examiner	Art Unit	
	Isaac M. Woo	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 December 2003.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 14-21 and 57-77 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 14-21 and 57-77 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 15 July 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/15/03</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is response to the application filed, on December 15, 2003.
2. Claims 14-21 and 57-77 are presented for examination.

Claim Objections

3. Claims 73-76 are objected to because of the following informalities: Claims 73-76 recite, "A computer program product according to Claim 66". Should it be , -- A computer program product according to Claim 67 - - ?. Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 14-21 and 57-77 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As set forth in MPEP 2106 (II) (A):

A. Identify and Understand Any Practical Application Asserted for the Invention

The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); *In re Ziegler*, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

Regarding claims 14 and 57, the method for improved searching for electronic documents can be implemented without computer or machine. Because the limitation of claim 14, "receiving" and "searching" and claim 57, "receiving" and "filtering", can be implemented by a human with a pencil, and a piece of paper for searching an electronic document. Thus, the languages of claims 14 and 57 raise a question as to whether the claimed method is directed merely to an abstract idea that is not tied to a producing a concrete, useful, and tangible result from the basis of statutory subject matter under 35 U.S. C. § 101. Therefore, the claimed invention is non-statutory subject matter. The claims should be amended to indicate that the subject matter is implemented by a computer, i.e., a computer implemented method.

As set forth in MPEP 2106 (II) (A):

Products may be either machines, manufactures, or compositions of matter.

A machine is "a concrete thing, consisting of parts or of certain devices and combinations of devices." *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 570 (1863).

.....

If a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in term of its hardware or hardware and software combination, it defines a statutory product. See, e.g., *Lowry*, 32 F.3d at 1583, 32 USPQ2d at 1034-35; *Waremerdam*, 33 F.3d at 1361-62, 31 USPQ2d at 1760.

Regarding claims 67 and 77, a computer program product and system, with *no physical structure of the machine in terms of its hardware or hardware and software combination*. Because the limitation of claims 67 and 77, “means for receiving ” and “means for filtering” are computer program product and software system that are not embedded any a computer-readable medium and run by any a computer or machine. Therefore, the claims are not a statutory system and should be rejected under 35 U.S.C. § 101 as not being tangible.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 57-77 are rejected under 35 U.S.C. 102(e) as being anticipated by Marcus et al (U.S. Patent No. 6,295,528, hereinafter, “Marcus”).

With respect to claim 57, Marcus discloses, receiving a set of electronic document addresses (uniform resource locator, URL is the address of web document,

col. 3, lines 45-62) and a desired geographic location (102, fig.2, geographic location in query request, col. 3, lines 45-62); and filtering (104, 108, perform query, fig. 4, col. 4, lines 39-67 to col. 5, lines 1-33) the set of electronic document addresses through a database to identify the electronic document addresses (performing query with parsing the URL(electronic document address)) that correspond to the desired geographical location, see (fig. 4, 108, perform query parameters including geographic location, query request according to query parameters, URL and geographic location, col. 3, lines 45-62, are performed), database including information about an electronic document and a corresponding geographical location (col. 3, lines 63-67 to col. 4, lines 1-9, database comprises electronic data), the geographical location being authenticated using an independent source, see (fig. 3, col. 4, lines 8-37, col. 3, lines 63-67 to col. 4, lines 1-9, "database maps geographic location" means that the geographic location is independent source from database itself).

With respect to claim 58, Marcus discloses, set of electronic document addresses (uniform resource locator, URL is the address of web document, col. 3, lines 45-62) is received at a geographic location filter of a search engine query interface (22, client, fig. 1), see (col. 3, lines 45-62, col. 2, lines 24-39).

With respect to claim 59, Marcus discloses, set of electronic document addresses (uniform resource locator, URL is the address of web document, col. 3, lines

45-62) is received from a search engine as search results (22, client, fig. 1, query requester), see (116, fig. 4, col. 5, lines 18-34, col. 3, lines 45-62, col. 2, lines 24-39).

With respect to claim 60, Marcus discloses, desired geographic location is search criteria used by the search engine to produce the search results, see (fig. 4, col. 5, lines 18-34).

With respect to claim 61, Marcus discloses, search criteria includes a keyword; see (query parameters are search keywords, col. 3, lines 45-67).

With respect to claim 62, Marcus discloses, identifying the electronic document addresses that are associated with the keyword, see (col. 3, lines 45-67).

With respect to claim 63, Marcus discloses, database includes records identifying a verified electronic document address of an electronic document and attributes of the electronic document, see (col. 4, lines 7-38).

With respect to claim 64, Marcus discloses, attributes include a geographic location associated with the electronic document, see (col. 4, lines 7-38, for instance, geographic location is attributes of document).

With respect to claim 65, Marcus discloses, geographical location being authenticated by a mechanism other than by the content of the electronic document, see (col. 4, lines 7-38, geographic location is controlled by different data source).

With respect to claim 66, Marcus discloses, receiving a keyword in connection with the geographic location; and identifying that the document addresses are associated with the keyword, see (col. 3, lines 45-67, document addresses are parsed to get query parameters that are query keywords).

With respect to claim 67, Marcus discloses, filter search results to determine that the results correspond to a desired geographical location by, see (urls are parsed to obtain query parameters that are used to get geographic location), receiving a set of electronic document addresses (uniform resource locator, URL is the address of web document, col. 3, lines 45-62) and a desired geographic location (102, fig.2, geographic location in query request, col. 3, lines 45-62); and filtering (104, 108, perform query, fig. 4, col. 4, lines 39-67 to col. 5, lines 1-33) the set of electronic document addresses through a database to identify the electronic document addresses (performing query with parsing the URL(electronic document address)) that correspond to the desired geographical location, see (fig. 4, 108, perform query parameters including geographic location, query request according to query parameters, URL and geographic location, col. 3, lines 45-62, are performed), database including information about an electronic document and a corresponding geographical location (col. 3, lines 63-67 to col. 4, lines

1-9, database comprises electronic data), the geographical location being authenticated using an independent source, see (fig. 3, col. 4, lines 8-37, col. 3, lines 63-67 to col. 4, lines 1-9, “database maps geographic location” means that the geographic location is independent source from database itself).

With respect to claim 68, Marcus discloses, set of electronic document addresses (uniform resource locator, URL is the address of web document, col. 3, lines 45-62) is received at a geographic location filter of a search engine query interface (22, client, fig. 1), see (col. 3, lines 45-62, col. 2, lines 24-39).

With respect to claim 69, Marcus discloses, set of electronic document addresses (uniform resource locator, URL is the address of web document, col. 3, lines 45-62) is received from a search engine as search results (22, client, fig. 1, query requester), see (116, fig. 4, col. 5, lines 18-34, col. 3, lines 45-62, col. 2, lines 24-39).

With respect to claim 70, Marcus discloses, desired geographic location is search criteria used by the search engine to produce the search results, see (fig. 4, col. 5, lines 18-34).

With respect to claim 71, Marcus discloses, search criteria includes a keyword, see (query parameters are search keywords, col. 3, lines 45-67).

With respect to claim 72, Marcus discloses, identifying the electronic document addresses that are associated with the keyword, see (col. 3, lines 45-67).

With respect to claim 73, Marcus discloses, database includes records identifying a verified electronic document address of an electronic document and attributes of the electronic document, see (col. 4, lines 7-38).

With respect to claim 74, Marcus discloses, attributes include a geographic location associated with the electronic document, see (col. 4, lines 7-38, for instance, geographic location is attributes of document).

With respect to claim 75, Marcus discloses, geographical location being authenticated by a mechanism other than by the content of the electronic document, see (col. 4, lines 7-38, geographic location is controlled by different data source).

With respect to claim 76, Marcus discloses, receiving a keyword in connection with the geographic location; and identifying that the document addresses are associated with the keyword, see (col. 3, lines 45-67, document addresses are parsed to get query parameters that are query keywords).

With respect to claim 77, Marcus discloses, means for receiving a set of electronic document addresses (uniform resource locator, URL is the address of web

document, col. 3, lines 45-62) and a desired geographic location (102, fig.2, geographic location in query request, col. 3, lines 45-62); and means for filtering (104, 108, perform query, fig. 4, col. 4, lines 39-67 to col. 5, lines 1-33) the set of electronic document addresses through a database to identify the electronic document addresses (performing query with parsing the URL(electronic document address)) that correspond to the desired geographical location, see (fig. 4, 108, perform query parameters including geographic location, query request according to query parameters, URL and geographic location, col. 3, lines 45-62, are performed), database including information about an electronic document and a corresponding geographical location (col. 3, lines 63-67 to col. 4, lines 1-9, database comprises electronic data), the geographical location being authenticated using an independent source, see (fig. 3, col. 4, lines 8-37, col. 3, lines 63-67 to col. 4, lines 1-9, “database maps geographic location” means that the geographic location is independent source from database itself).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 14-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wills (U.S. Patent No. 6,202,065) in view of Andrew (U.S. Patent No. 6,324,645, hereinafter, "Andrew").

With respect to claim 14, Wills discloses, receiving a desired geographic location (info query stating proximity to desired place name by information seeker, fig. 3) at a query interface (information seeker's user interface computer screen, fig. 3, col. 6, lines 25-48), see (fig. 3, 12, fig. 6, 18, fig. 7, col. 5, lines 45-67 to col. 6, lines 1-16, submit query with place name or in conjunction with distance, etc); searching a database (100, relevant documents, fig. 3) to identify electronic documents (100, relevant documents, fig. 3) that match the desired geographic locations the database including information about an electronic document and corresponding geographical location (URLs of matched document, fig. 3), the geographical location being authenticated using an independent source (200, geographical index, fig. 3, fig. 9, col. 7, lines 34-43, geographical index is a database that is different database from the relevant document database of 100, fig. 3, according to user's geographical input, the geographical index matches document that matches the user's input), see (col. 6, lines 63-67); and returning an authenticated set of addresses (URLS of document, fig. 3) of the electronic documents (URLs of documents with latitude and longitude references satisfying the specified proximity) which match the desired geographic location (with latitude and longitude references satisfying the specified proximity), see (col. 6, lines 63-67, search results (retrieved document with address, URLs) to information seeker, fig. 3). Wills

discloses searching database, see (100, relevant documents, fig. 3). Wills does not explicitly disclose, searching an authenticated digital certificate database. However, Andrew discloses the authenticated digital certificate database, see (col. 2, lines 58-67 to col. 2, lines 1-60). Therefore, in view of Andrew, it would have been obvious to a person having ordinary skill in the art at the invention made to modify Wills by incorporating the authenticated digital certificate database to make information certificated, save and access on authenticated digital certificate database. An authenticated digital certificate document or data is encrypted data for security. And certificate authority (CA or "Trusted Third Party") that issues digital certificates to other entities (organizations or individuals) to allow them to prove their identity to others. A Certificate Authority might be an external company such as VeriSign that offers digital certificate services or they might be an internal organization such as a corporate MIS department. The Certificate Authority's chief function is to verify the identity of entities and issue digital certificates attesting to that identity. The process uses public key cryptography to create a "network of trust". The hash function must be cryptographically strong. Thus, one having ordinary skill in the art at the time the invention was made would have been motivated to use such a modification because it would be beneficial to use certificate data from certificated database for secure data and data transaction in data retrieval system.

With respect to claim 15, Wills discloses, providing a keyword (fig. 3, 12, fig. 6, 18, fig. 7, col. 5, lines 45-67 to col. 6, lines 1-16, submit query with place name or in

conjunction with distance, etc, are keywords) to the query interface, see (info query stating proximity to desired place name by information seeker, fig. 3 from information seeker's user interface computer screen, fig. 3, col. 6, lines 25-48); and matching the keyword when searching for electronic documents, see (URLS of document, fig. 3).

With respect to claim 16, Wills discloses, query interface is implemented as a Web browser plug-in, see (URLS of document are displayed on web browser, fig. 3).

With respect to claim 17, Wills discloses that the searching is triggered by the geographic location provided to the query interface, see (info query stating proximity to desired place name by information seeker, fig. 3 from information seeker's user interface computer screen, fig. 3, col. 6, lines 25-48);

With respect to claim 18, Wills discloses, authenticated set of electronic document addresses to those within a predefined proximity of the geographic location, see (search results with latitude and longitude references satisfying the specified proximity, col. 6, lies 63-67, retrieved document with address, URLs, to information seeker, fig. 3).

With respect to claim 19, Wills discloses, predefined proximity is automatically generated based upon the keyword, see (submit query with place name or in conjunction with distance, etc, are keywords. info query stating proximity to desired

place name by information seeker, fig. 3 from information seeker's user interface computer screen, fig. 3, col. 6, lines 25-48).

With respect to claim 20, Wills discloses, proximity is automatically adjusted based upon the authenticated set of electronic document addresses returned, see (col. 6, lines 25-49).

With respect to claim 21, Wills discloses, creating at least one electronic document associated with the set of electronic document address, see (col. 6, lies 63-67, retrieved document with address, URLs, to information seeker, fig. 3).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac M. Woo whose telephone number is (571) 272-4043. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IMW
October 27, 2005